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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

APL 14

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on _____

Signature _____

Typed or printed
name _____

Application Number

10/764,647

Filed

1/26/2004

First Named Inventor

TRAN

Art Unit

2176

Examiner

SINGH

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☒ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☐ attorney or agent of record.
Registration number _____

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____



Signature

BAO TRAN

Typed or printed name

408528 7490

Telephone number

8/3/06

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.



*Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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AUG 3 - 2006

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

TRAN

Application No.: 10/764,647

Filed: 1/26/2004

Title: SYSTEMS AND METHODS FOR
ANALYZING DOCUMENTS

Examiner: SINGH, RACHNA

Art Unit: 2176

PRE-APPEAL BRIEF

Commissioner for Patents

PO Box 1450

Alexandria, VA 22313

Sir:

Applicant appeals the rejections made in the Final Office Action as follows:

I. CLAIMS 1-7, 10-15, AND 19-21 ARE PATENTABLE UNDER 35 U.S.C. 103(A) OVER GONZALES, US 2002/0161603 IN VIEW OF SWEET, US 6,567,799 B2

Gonzales relates to a World Wide Web publishing system for managing content of an article. Sweet relates to techniques for displaying hypertext data. However, neither Gonzales nor Sweet renders the claims unpatentable as neither shows a method for providing an electronic document having first, second and third portions, and where the method includes embedding one or more links in the first portion referencing one or more external documents viewable using a viewer application; and embedding one or more links in the third portion referencing information contained in the second portion.

The combination of Sweet with Gonzales would result in web pages with links that can "connect two web pages, i.e., an internal link, or two web sites, i.e., an external link" (Gonzales paragraph 47) and links that would bring up a PDF (Sweet Col. 8, lines 26-50). However, such combination would not provide the specific structure and connections between the claimed structures, namely links in the first portion referencing

one or more external documents viewable using a viewer application; and links in the third portion referencing information contained in the second portion. As the dependent claims spell out in detail, the specific structure of the first, second and third portions is quite important for certain documents such as patent documents.

The combination is an impermissible reconstruction of the instant invention using hindsight from the teachings of the present application. Even with the benefit of hindsight, the combination of Gonzales and Sweet results in an inoperative system. The combination cannot provide the benefit of the inventive system, which includes the ease of reviewing or comprehension of a document (such as a PDF copy of a patent) through explanatory links. For example, with the invention, a word in the third portion (the claim) of a document can be linked with a corresponding word in the second portion (the description) in the same document so that a reader can quickly ascertain and readily interpret the meaning of the wording used in the claim. In this example, the first section (the cited art) contains links that when selected brings up an external document viewable using a viewer such as a PDF viewer.

Moreover, Gonzales and Sweet fail to teach the language of the dependent claims. For example, as to claim 2, there is no showing that Gonzales and Sweet show a document in a portable document format (PDF) document residing in a PDF file, where one or more links are embedded in the first portion referencing one or more external documents viewable using a PDF viewer application; and where one or more links are embedded in the third portion of the PDF document referencing information contained in the second portion of the PDF document. As to claim 3, there is no showing of the elements of claim 2, with the addition of encapsulating said one or more links into said PDF file.

As to claim 4, there is no showing of a PDF viewer application to render a PDF file, where one or more links are embedded in the first portion referencing one or more external documents viewable using the PDF viewer application; and where one or more links are embedded in the third portion of the PDF document referencing information contained in the second portion of the PDF document..

As to claim 5, the references do not suggest or teach embedding one or more links in the first portion referencing one or more external documents viewable using a viewer

application; and embedding one or more links in the third portion referencing information contained in the second portion, and retrieving one or more pages of an external document referenced by a link in the first portion and consolidating all pages into the external document.

As to claim 6, the references are completely devoid of showing a patent or a patent application and wherein the first portion comprises a prior art section, the second portion comprises a description section, and the third portion comprises a claim section, comprising cross-referencing an element in the claim section against one or more references to the element in the specification section.

As to claim 7, the references do not show the specifics of cross-referencing the element in the claim section against one or more references to the element in the one or more external documents.

As to claim 10, the references do not teach or suggest retrieving a file history for the patent or the patent application and cross-referencing the element in the claim section against one or more references to the element in the file history.

As to claim 11, there is no teaching of cross-referencing the element against equivalent terminology for the element in the specification section or in the one or more external documents.

As to claim 12, there is no showing that the references perform searching a database for related external documents in conjunction with an electronic document having first, second and third portions, and where the method includes embedding one or more links in the first portion referencing one or more external documents viewable using a viewer application; and embedding one or more links in the third portion referencing information contained in the second portion. As to claim 13, there is no further showing of claim 12 and the database being located on the Internet.

As to claim 14, the references fail to show claim 1 and further wherein the electronic document comprises a patent or a patent application and wherein the first portion comprises a prior art section, the second portion comprises a description section, and the third portion comprises a claim section, further comprising cross-referencing an element in the claim section against one or more references to the element in the one or more related external documents.

As to claim 15, the references do not show mapping intellectual property for an industry covered by the patent or the patent application.

As to claims 19-21, as discussed above, the references do not show an electronic document having first, second and third portions, and where the method includes embedding one or more links in the first portion referencing one or more external documents viewable using a viewer application; and embedding one or more links in the third portion referencing information contained in the second portion. Withdrawal of the Section 103 rejection on these claims is requested.

II. CLAIMS 8-9 ARE PATENTABLE UNDER 35 U.S.C. 103(A) OVER GONZALES IN VIEW OF SWEET ET AL AND FOQEL ET AL., US 2004/0059994.

Claims 8-9 were rejected under 35 U.S.C. 103(a) as being unpatentable over Gonzales in view of Sweet et al, and further in view of Foquel et al., US 2004/0059994. Foquel relates to a method for checking semantic and syntactical correctness of patent claims. The method first checks for sequential claims numbering. For each claim a type and dependency are determined and the dependencies are checked for type match. Each claim is then parsed and checked for syntactical correctness and for correct antecedent basis for all its terms.

A careful review of the references do not suggest combining the references to arrive at systems and methods for providing an electronic document having first, second and third portions by embedding one or more links in the first portion referencing one or more external documents viewable using a viewer application; and embedding one or more links in the third portion referencing information contained in the second portion. Moreover, there is no suggestion to combine Gonzales with a document where the first portion comprises a prior art section, the second portion comprises a description section, and the third portion comprises a claim section, comprising cross-referencing an element in the claim section against one or more references to the element in the specification section and where one or more claims are visualized in a tree view. Similarly, there is no suggestion where the document supports drilling down details of each claim in the tree view. Since these recitations are not present in Gonzales or Sweet or Foquel, the rejection must be withdrawn and the claims allowed.

III. CLAIMS 16-17 ARE PATENTABLE UNDER 35 U.S.C. 103(A) OVER GONZALES IN VIEW OF SWEET ET AL. AND MAHONEY ET AL., US 5,999,664. CLAIM 18 IS PATENTABLE OVER GONZALES, IN VIEW OF SWEET ET AL., AND FURTHER IN VIEW OF BARQUERON ET AL., US 2004/0205542 AL, 10/14/04.

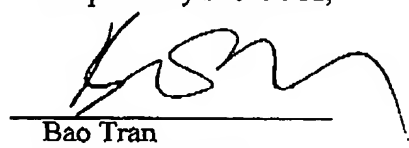
Claims 16-17 were rejected under 35 U.S.C. 103(a) as being unpatentable over Gonzales in view of Sweet et al., and further in view of Mahoney et al., US 5,999,664. Claim 18 was rejected under 35 U.S.C. 103(a) as being unpatentable over Gonzales, in view of Sweet et al., and further in view of Barqeron et al., US 2004/0205542 A1, 10/14/04.

Again, these claims are allowable as they depend from allowable independent claims. Further, there is no suggestion to combine the references. A careful review of the references do not suggest combining the references to arrive at systems and methods for providing an electronic document having first, second and third portions by embedding one or more links in the first portion referencing one or more external documents viewable using a viewer application; and embedding one or more links in the third portion referencing information contained in the second portion. Moreover, there is no suggestion to combine the references to provide generating text using optical character recognition (OCR) from an image of a page of the document and associating the text with the corresponding location of the text in the image. The references do not suggest the additional recitation of text searchable PDF document. There is no suggestion of additional saving user annotation in the document. For these reasons, the rejections should be withdrawn and all claims allowed.

If for any reasons the Examiner believes a telephone conference would in any way expedite resolution of the issues raised in this appeal, the Examiner is invited to telephone the undersigned at 408-528-7490.

Respectfully submitted,

By:


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